Remarks

Claims 1-26 are pending in the present application, claims 14-26 having been added by this amendment.

Applicants traverse the rejection of claims 1-13 as obvious over de Heus et al. in view of Nussbaum et al.

Claim 1, and claims 2-13 dependent thereon, specify a method of assembling first and second different books, wherein the method includes the steps of storing a first number of pages and specifying pagination information including an indication of whether a stored page is to be selectively included in the first book. The method further includes the step of determining whether a stored page is to be assembled into the first book based on the pagination information, wherein a total number of stored pages to be assembled into the first book is less than the first number. Still further, the method includes the steps of generating page description language instructions for production of the first and second books in accordance with the pagination information and producing the first and second books in a single press run.

Added claims 14-26 are ultimately dependent upon and specify further steps in the method of claim 1.

Neither de Heus et al. nor Nussbaum et al. discloses or suggests a method of assembling first and second different books, including the step of producing first and second books in a single press run, as specified by the claims of the present application.

In fact, de Heus et al. discloses a pagination system and process for paginating types of printed book directories such as telephone books, membership directories, catalogues, etc. For each type of directory, the pagination system accepts a plurality of data entries and a set of layout and pagination parameters. The data entries and layout and pagination parameters are specified for each directory type. The system uses the layout parameters to define the general appearance or physical characteristics of a book page or sections of the book and the pagination parameters are used during pagination to control the position of the display entries and anchor listings and headings relative to the column and page boundaries. During pagination, an optimal page layout is created for each page of the book directory in order to minimize waste of available printing space. Page description language is generated for each

page of the book directory for production thereof on a suitable output device such as a laser printer or typesetter. Significantly, all of the book directories of a particular directory type are identical to one another as printed.

Nussbaum et al. teaches a custom book assembly and binding system wherein a combination of pages is selectively included in a book assembly. According to Nussbaum et al., in order to create multiple distinct copies of a book, more than a single press run is required. Nussbaum et al. proposes increasing processing speeds by using shorter bindery lines. To facilitate the use of fewer hoppers, the hoppers used must be continually recycled or reused for more than one set of signatures. (See Column 4, Lines 18-25.)

Because the art does not disclose or suggest that it would be desirable or even possible to provide a method of assembling first and second different books including the steps of storing a first number of pages, specifying pagination information including an indication of whether a stored page is to be selectively included in a first book, determining whether a stored page is to be assembled into the first book based on the pagination information, wherein a total number of stored pages to be assembled in the first book is less than the first number, generating page description language instructions for production of the first and second books in accordance with the pagination information, and producing first and second books in a single press run, as specified by the claims at issue, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the obviousness rejection should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and allowance thereof are respectfully requested.

Respectfully submitted,

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